UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,472	02/05/2004	Daniella Licht	2609/68585-A/JPW/GJG/JBC	7030

7590 11/30/2007

John P. White
Cooper & Dunham LLP
1185 Avenue of the Americas
New York, NY 10036

EXAMINER	
CHANNAVAJJALA, LAKSHMI SARADA	
ART UNIT	**PAPER NUMBER**
1615	

MAIL DATE	DELIVERY MODE
11/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/773,472	LICHT ET AL.	
	Examiner	Art Unit	
	Lakshmi S. Channavajjala	1615	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 November 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☐ Claim(s) *1-29,38-76,82-92 and 108-119* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) *1-29,38-76,82-92 and 108-119* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *2-5-04* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date 6/24/04; 7/2/04
4) ☒ Interview Summary (PTO-413) Paper No(s)/Mail Date. 11-27-07
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

In response to the interview dated 11-27-07 (Interview summary attached hereto), the office action dated 9-28-07 has been vacated and the present action has been issued.

Receipt of PRELIMINARY AMENDMENT dated 2-5-04, IDS dated 6-24-04 and 7-2-04 is acknowledged.

Claims 1-29, 38-76, 82-92,108-119 are pending. Claims 30-37, 77-81, 93-107 and 120 have been canceled.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-29, 38-76, 82-92,108-119 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-55 of copending Application No. 10/772,911 in view of US 4,704,285 ('285). Instant claims as well as the co-pending claims are directed to compressible tablets comprising valproic acid or its salts as an active agent, excipients such as HPMC, magnesium stearate, fillers, lubricants etc. Both sets of claims are directed to treating epilepsy, pain and conditions such as bipolar disorder with the above composition. Instant claims differ from the co-pending claims in that instant claims recite HPMC in addition to the binder, whereas the co-pending claims recite hydroxypropyl cellulose and a disintegrant. The co-pending claims fail to claim the specific viscosity or the percentages of the methoxy or hydroxypropyl content of HPMC. Further, instant claims release sustained and the copending claims have been amended to recite immediate release.

'285 teach compressible tablet preparation with HPMC ether fine particles as a matrix (col. 2, L 7-25). In addition to the active agents and HPMC ether, '285 teach inclusion of HPMC as a hydrocolloid and suggests that the particle size of HPMC is such that at least 70% pass through 100 mesh, with a HP content of 4%-12% and methoxy content of 19% to 30% (see col. 3, L 37-55). Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include HPMC such as that described by 285 in the compressible composition of instant claims because all the references are directed to compressible tablets and '285 teach that the claimed HPMC are routinely employed in compressible tablet preparation for improving the flow properties of the tablet. '285 further teach that the viscosity of HPMC

is between 100 to 10,000 cps. Thus, the % of the MC and HP contents, viscosity and the particle sizes of instant claims are encompassed by the ranges of prior art. With respect to the claimed release rates, both sets of claims are directed to the same method of treatment with the same active compound and accordingly, optimizing the individual amounts of the components of the composition so as to achieve the desired release for an effective treatment with the active agent would have been obvious for a skilled artisan. This is a provisional obviousness-type double patenting rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1-4, 7-11, 14-20, 29, 38-46, 53-72, 76, 82-89 and 108-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2001/0005512 to Anderson in view of Remingtons' Pharmaceutical Sciences (1990).

OR

Claims 1-4, 7-11, 14-20, 29, 38-46, 53-72, 76, 82-89 and 108-119 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,419,953 to Qiu et al in view of Remingtons' Pharmaceutical Sciences (1990).

Anderson teaches a pharmaceutical composition comprising valproate compounds such as divalproex sodium as an active agent. For the dosage forms containing the active agent, Anderson teaches tablet formulations comprising the active agent and hydroxypropyl cellulose, which read on the instant components i) and ii). For the instant filler, Anderson teaches microcrystalline cellulose and lactose in the above dosage form. For the instant lubricant, Anderson teaches magnesium stearate (paragraphs 0107 – 0114). Anderson also teaches the active agents for the same treatment i.e., epilepsy and bipolar disorder (col. 1-2). Anderson teaches the various tabletting ingredients as percentages of the total weight of the tablet as opposed to the amounts and the tablets of Anderson are prepared in the same manner (compression tablets) as that claimed in the instant i.e., admixing the predetermined amounts and compressing the tablets. Anderson also teaches the excipients for the same purpose i.e., filler, lubricant etc and accordingly, optimizing the amount of an excipient with an

expectation to achieve the desired tabletting effect such as lubrication, increasing the bulk (with a filler) etc., would have been within the scope of a skilled artisan.

Qiu et al (Qiu) teaches controlled release composition comprising an anti-epileptic agent, valproic acid or its salts such as an ester, amide etc., prepared by intimately mixing the components of the composition and compression method (lines bridging col. 2-3 & col. 5, L 8-20). The composition, in the form of tablets, contains hydroxypropyl methylcellulose (examples formulations) and excipients such as magnesium stearate, lactose, microcrystalline cellulose (col. 3, L 1-53 & col. 5).

Both Anderson and Qiu fail to teach additional binder and also the specific HPMC with the claimed percentages of HP and MC contents, viscosity, particle sizes etc., in the composition comprising valproic acid or its salts. However, both the references are directed to preparing compressed dosage forms for a controlled release of active agent.

Remingtons' Pharmaceutical Sciences (Remingtons') teach oral dosage forms, particularly, compressed tablets comprising the tabletting excipients such as diluents, binders, disintegrants, glidants etc (pages 134-1637). Remingtons' teach that binders impart cohesiveness to the tablets formulations, which ensures that the tablet remains intact after compression, as well as improving the free-flowing qualities by the formulation of granules of desired hardness and size (page 1635). Among the binders, Remingtons' teach the instant starch, gelatin, sugars; gums, polyethylene glycol, waxes, ethylcellulose etc., and in particular teach instant claimed cellulose binders such as

hydroxypropyl cellulose or hydroxyethyl cellulose (page 1636, col. 1, last paragraph). Thus, it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to use a single or more than binder of Remingtons' in the compression tabletting composition of Anderson or Qiu because Remingtons' teach that teach that binders impart cohesiveness to the tablets formulations, which ensures that the tablet remains intact after compression, as well as improving the free-flowing qualities by the formulation of granules of desired hardness and size. Accordingly, depending on the cohesiveness or hardness of the tablet desired, a skilled artisan would have employed an appropriate amount of a binder in the composition of Anderson or Qiu. Further, with respect to the composition claims reciting specific amounts of fillers, active agent and the disintegrants, absent any unexpected result optimizing the amounts of each of the active agent or the tabletting ingredients (lubricant, filler, disintegrant, release polymer) so as to achieve the desired release rate would have been within the scope of a skilled artisan. For the specific release rates claimed, both Anderson and Qiu recognize the importance of valproic acid in treating the claimed conditions such as epilepsy and also teach the claimed excipients. Accordingly, optimizing the individual amounts of the components of the composition so as to achieve the desired release for an effective treatment with the active agent would have been obvious for a skilled artisan.

3. Claims 5-6, 12-13, 21-28, 47-52, 73-75 and 90-92 are rejected under 35 U.S.C. 103(a) as being unpatentable over US2001/0005512 to Anderson in view of

Remingtons' Pharmaceutical Sciences (1990) **OR** over US 6,419,953 to Qiu et al in view of Remingtons' Pharmaceutical Sciences (1990) as applied to claims 1-4, 7-11, 14-20, 29, 38-46, 53-72, 76, 82-89 and 108-119 above, and further in view of US 4,704,285 ('285).

Anderson, Qiu and Remingtons', all of the references described above, fail to teach the claimed viscosity of cellulose compounds, % distribution of HP and MC constituents and particle size distribution.

'285 teach compressible tablet preparation with HPMC ether fine particles as a matrix (col. 2, L 7-25). In addition to the active agents and HPMC ether, '285 teach inclusion of HPMC as a hydrocolloid and suggests that the particle size of HPMC is such that at least 70% pass through 100 mesh, with a HP content of 4%-12% and methoxy content of 19% to 30% (see col. 3, L 37-55). '285 further teach that the viscosity of HPMC is between 100 to 10,000 cps. Thus, the % of the MC and HP contents, viscosity and the particle sizes of instant claims are encompassed by the ranges of prior art. While 285 do not teach the claimed drug, the reference states any drug may be included in the composition. It would have been obvious for one of an ordinary skill in the art at the time of the instant invention was made to include HPMC such as that described by 285 in the compressible composition of Anderson or Qiu because all the references are directed to compressible tablets and '285 teach that the claimed HPMC are routinely employed in compressible tablet preparation for improving the flow properties of the tablet and also to achieve sustained release of the active agent from the tablets due to delaying of the release of the active agent by the fine

particle nature of the cellulose materials (see lines bridging col. 1-2 of '285). A skilled artisan would have expected to achieve the desired delay in the release of valproic acid or its derivatives of Anderson or Qiu with the incorporation of the cellulose materials of '285 in addition to the excipients taught by Remingtons'.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lakshmi S. Channavajjala whose telephone number is 571-272-0591. The examiner can normally be reached on 7.00 AM -4.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward can be reached on 571-272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AU 1615
November 27, 2007

LAKSHMI S. CHANNAVAJJALA
PRIMARY EXAMINER